REMARKS

Favorable consideration of this Application as presently amended and in light of the following discussion is respectfully requested.

By way of summary, the Official Action presents the following issues: Claim 1-3, 26-35 and 38 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-5 of US 6,703,048 (" '048 patent") in view of US 6,723,429 (" '429 patent") ; Claims 1-13, 26-35 and 38 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 4, 6-9, 11-17 and 19-26 of the '429 patent; Claims 1-13, 26-35 and 38 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 2, 11, 13-16 of US 6,593,470 (" '470 patent") in view of the '429 patent; Claims 1-13, 26-35 and 38 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-32 of US 6,562,459 (" '459 patent") in view of the '429 patent; and the application allegedly contains claims directed to several distinct species. The applicant respectfully traverses these rejections.

INFORMATION DISCLOSURE STATEMENT

Applicants respectfully direct the Examiner's attention to the Information Disclosure Statement (IDS) filed with the application on February 6, 2004. Applicants note that this IDS has yet to be indicated as considered by the Examiner. As such, Applicants respectfully

requests that the Examiner provide an initialed PTO/SB/08a/b form in the next communication.

DOUBLE-PATENTING REJECTION

The Official Action has provisionally rejected Claims 1-13, 26-35 and 38 under the judicially created Doctrine of Obviousness-type double patenting over Claims 1-5 of '048 patent in view of the '429 patent. The Official Action has provisionally rejected Claims 1-13, 26-35 and 38 under the judicially created Doctrine of Obviousness-type double patenting over Claims 1, 2, 11 and 13-16 of the '470 patent in view of the '429 patent. Claims 1-13, 26-35 and 38 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 2, 11, 13-16 of the '470 patent in view of the '429 patent. Claims 1-13, 26-35 and 38 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-32 of the '459 patent in view of the '429 patent.

In response, Applicants have filed herewith a Terminal Disclaimer. Accordingly, Applicants respectfully request that the double-patenting rejection be withdrawn.

The filing of a Terminal Disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. The "filing of a Terminal Disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 U.S.P.Q.2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached

disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection. For the above reasons, this rejection should be withdrawn.

PROVISIONAL ELECTION

In response to the outstanding Official Action' election of species requirement, Applicants provisionally elect with traverse group 3 "biocatalytic process" and identify Claims 1, 3, 5-13 and 26-38 readable on the provisionally elected species.

Applicants respectfully traverse the election requirement for several reasons.

First, the outstanding Official Action **does not** include any statements that state any basis whatsoever in support of such a finding. This is contrary to MPEP § 816, which states:

MPEP § 816

> The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. . . .

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness. Again, there are no statements!

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive features and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

MPEP § 803

> . . . If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

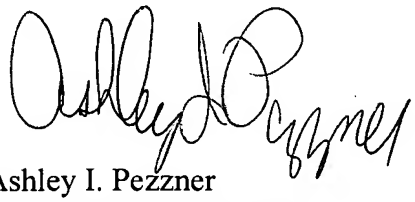
The claims of the present invention would appear to be part of an overlapping search area. There is no burden on the Examiner to search this invention.

In fact the Examiner has already searched the claims due to the fact that the Examiner has rejected all the claims. Clearly, there is no burden on the Examiner.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 08196-00017-US from which the undersigned is authorized to draw. If the Examiner believes that any additional formal matters need to be addressed in order to place this Application in condition for allowance, the Examiner is respectfully requested to contact the undersigned by telephone at the Examiner's convenience.

Respectfully submitted,

CONNOLLY, BOVE,
LODGE & HUTZ, L.L.P.



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